

REMARKS:

Claims 1-4 and 13 have been cancelled without prejudice or disclaimer. Claims 5, 8, 10-12, 17 and 18 have been amended and new claim 19 has been added. Claims 5, 8-12 and 17-19 are now pending in this application. Consideration of the claims as now presented is requested.

Claims 8 – 12 and 17-18 have been rejected under 35 US 103(a) as being unpatentable over Gateway 2000 Press Release August 20, 1996 (Gateway 2000), US Patent 5,191,413 (Yoshida), US Patent 5,629,733 (Youman), US Patent 5,675,390 (Schindler) and US L;M,L Patent 5,963,269 (Beery). This ground of rejection is respectfully traversed. On its face, a rejection requiring citation of six references to reject a claim (claim 8) containing six operative features strongly suggests use of improper hindsight in formulating the rejection by attempting to map individual features in the rejected claim to individual features arbitrarily selected from diverse references, without properly considering the teaching of each reference considered in its entirety in relation to the claimed invention considered as a whole. Note MPEP 2141, 2141.02. The cited references do not suggest the desirability of making the combination set forth in claim 8, and lead away from the claimed combination. Note MPEP 2143, 2143.01. The grounds of rejection as stated in the Office Action fall short of showing that the cited references teach all the limitations set forth in claim 8. Note MPEP 2143.03. Consequently, with respect, the rejection of claim 8 as well as of claims dependent from claim 8 should be withdrawn.

More particularly, Youman's disclosed channel name entry differs significantly from that claimed in claim 8. Youman teaches, in relation to Fig. 38D-F the use of up/down arrow keys to cycle through the letters of the alphabet and the digits 0-9 for display in character boxes 330, selected by a cursor. After display of a desired character, depressing a right or left arrow key moves the cursor to another character box for the selection procedure using the up/'down arrow keys, to be repeated. This does not disclose or suggest what is claimed in claim 8. Moreover, Youman's disclosed implementation is

significantly different from that of Yoshida and would have been a disincentive to a person of ordinary skill in the art to have attempted modification of Yoshida's simpler character entry procedure using actuation of alphanumeric keys, by use of the more complicated and cumbersome methodology taught by Youman. With respect, the position stated in the Office Action appears to be based on conclusory, hindsight rationalization.

In attempting to make up for other shortcomings of Yoshida and Youman, the Office Action cites Beery '269 who discloses (see col. 14, lines 1236; lines 58-62; col. 15, lines 15-19) storage of television program labels together with user keystroke entry sequence ("input label") which, if the sequence matches a stored programmed label initiates in program controlled tuning. Beery also discloses (col. 19, lines 53-58) that *"it may be desirable to provide a display legend corresponding to each of the stored labels that will give to the operator a readable channel identification word or phrase on the screen on channel selection. Thus upon selection of "HBO" by entering keystrokes "4, 2, 6", a display entry in ROM containing the alphabetic characters "HBO" may be retrieved from ROM at the same time the label entry in ROM is identified (see block 116 in FIG. 4)."* (Underlining added.) Thus, this label display is concerned with display, not during channel selection for tuning, but during the "stored label" activation process described with reference to Fig. 4 (col. 7, line 21 – col. 5, line 23). This is distinct from and does not disclose or suggest what is claimed in claim 8.

US Patent 5,045,947 (Beery) also has been noted and is listed in the accompanying Information Disclosure Statement. Beery '947 discloses channel selection by select code entry or by scrolling. In relation to the scrolling function, Beery describes *"Each time a scroll key is actuated, program operation advances to the next item in the cue [sic]. This entry is checked for the presences of a marker bit. If none is found, the program simply advances through the cue until a marker is found. The corresponding channel is then displayed on the screen, and the appropriate display code is also presented."* (See col. 11, lines 17-26.) Thus, Beery '947 is distinct from and does not disclose or suggest what is claimed in claim 8.

Although not concurring with specific grounds of rejection advanced against particular dependent claims in the Office Action, it is urged that all pending dependent claims, including new claim 19, are patentable for at least the same reasons advanced in respect of claim 8.

In summary, the rejections of claims 5, 8-12 and 17-19 under 35 US 103 are seen to be hindsight motivated and improperly based on the teachings of the invention disclosed and claimed in this application. The rejection is based on arbitrary selection of individual features from references having distinct teachings and requiring changes in the principles of operation of the references beyond the teachings thereof. The Office Action asserts significant modification of individual references, one by another, in manner neither disclosed nor suggested by the references, into an aggregation which, as discussed in the preceding commentary, still falls short of the invention as claimed in claim 8 or any of its dependent claims. That individual features in the claimed invention may have been within the skill of the art at the time of the claimed invention does not itself render the claimed invention obvious and the Office Action has not shown any objective basis for making the overall combination of claimed features set forth in claim 8 or its dependent claims. This is demonstrative that the claimed invention proceeds beyond exercise of normal skill in the art on the basis of the references at the time of the claimed invention, and represents a patentable advance in the art. To justify rejection under 35 US 103, a claimed invention must have been taught or suggested by the prior art, on an antecedent basis, at the time of the claimed invention. That a claimed invention hypothetically might, after the fact, be assembled from the prior art does not negate patentability of the claimed invention is emphasized by prevailing case law and MPEP 2143.01. Favorable consideration is therefore respectfully requested.

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If any issues should remain, the Examiner is invited to telephone the undersigned attorney (972-490-3695) so that such issues may be discussed with a view to prompt resolution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "N. Rhys Merrett". The signature is fluid and cursive, with a large initial "N" and "R".

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VERSION WITH MARKINGS SHOWING CHANGES MADE

5. (Twice Amended) The method computer system of claim 4~~8~~, wherein said ~~alphanumeric keyboard is a wireless keyboard. provides said alphanumeric information to said computer system in a wireless fashion.~~

8. (Amended Four Times) In a PC/TV computer system having keyboard for providing alphanumeric characters to said PC/TV computer and also having a display monitor, a method of selecting a network station comprising the steps of:

storing by a manufacturer predetermined network station names;

placing said PC/TV computer in one of a TV mode and a Computer mode ~~with an active video window;~~

pressing a first alphanumeric key on said keyboard;

~~determining whether said first alphanumeric key designates a character which is a first character in one or more predetermined network station names;~~

creating a monitor displaying of the or each said stored network station name containing a said matching first character matching the character associated with said first alphanumeric key on said monitor; and

effecting user input to the system to mark the or a user selected displayed network station name; and

then effecting user input to the system to tune tuning to a network station corresponding to the a user selected displayed network station name marked by said user input.

10. (Twice Amended) The method of claim 8, wherein the or a user selected each displayed network station name containing a matching first character is highlighted.

11. (Amended) The method of claim 8, wherein said ~~step of displaying~~ monitor display is performed effected in by providing an active window of said display on a screen of a viewing monitor when the system is in said Computer mode.

12. (Twice Amended) The method of claim 8, wherein the step of displaying is performed by providing a channel banner on ~~a screen of the~~ a viewing display monitor.

17. (Twice Amended) The method of claim ~~816~~, wherein said user input to tune to a network station ~~selection of a displayed station name~~ is effected by actuation of a key on said keyboard.

18. (Twice Amended) The method of claim ~~816~~, wherein said user input to tune to a network station ~~selection of a displayed station name~~ is effected by user operation of a pointing device.

Please add the following new claim:

19. The method of claim 8, wherein in said TV mode said PC/TV has a full screen display and no user accessible PC functionality and in said Computer mode said PC/TV has user accessible PC functionality and a video window in said display.